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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,750	10/23/2003	Joachim B. Kohn	P22,591-D USA	7747
23307	7590	10/21/2004	EXAMINER	
SYNNESTVEDT & LECHNER, LLP 2600 ARAMARK TOWER 1101 MARKET STREET PHILADELPHIA, PA 191072950			JONES, DAMERON L.	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/691,750

**Applicant(s)**

KOHN ET AL.

**Examiner**

D. L. Jones

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

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## APPLICANT'S INVENTION

1. Applicant's invention is directed to a radio opaque device comprising a radio opaque iodine- or bromine-substituted polymer as set forth in independent claims 1 and 18.

**Note:** Claims 1-34 are pending.

## DOUBLE PATENTING REJECTIONS

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-41 of copending Application No. 10/288,076. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to radio opaque devices comprising a radio opaque iodine- or bromine-substituted polymer. The claims differ in that the claims of 10/288,076 are broader than those of the instant invention. Thus, a skilled practitioner in the art would recognize that the radio opaque polymer formula of independent claim 14 of 10/288,076 encompasses that of independent claims 1 and 18 as set forth in the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-41 of copending Application No. 10/691,749. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to radio opaque biocompatible polymers. The inventions differ in that independent claims 1 and 18 of instant invention are directed to specific polymer structures. However, a skilled practitioner in the art would recognize that the radio opaque polymer formula of instant invention is encompassed by the text of 10/691,749.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-41 of copending Application No. 10/796,847. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to radio opaque biocompatible polymers. The inventions differ in that independent claims 1 and 18 of the instant invention are directed to specific polymer structures. However, a skilled practitioner in the art would recognize that the radio opaque polymer formula of the instant invention is encompassed by the text of 10/796,847.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,602,497. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a biocompatible polymer wherein the polymer is optionally radiolabeled with iodine or bromine. The claims differ in that those of the instant invention are specifically directed to a radio opaque while the claims of 6,602,497 do not require a radio opaque. However, a skilled practitioner in the art would recognize from the disclosure of claim 5, lines 13-18, that the invention of 6,602,497 encompasses radio opaque devices since it is disclosed that

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polyether containing iodine or bromine are radio opaque and useful in medical implant application.

## 112 REJECTIONS

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-34: The claims as written are ambiguous because the variable 'N' as set forth in the formulae of independent claims 1 and 18 are undefined. If Applicant is in disagreement with the Examiner, it is respectfully requested that Applicant point to page(s) and line number(s) wherein support may be found.

Note: It is duly noted that the variable 'N' was not defined in the provisional application (60/064,905).

Claim 18, line 18: The claim as written is ambiguous because it is unclear whether Applicant intended the range of the variable 'g' to be negative values. In particular, the phrase 'g ranges from zero to less than one' is confusing.

## SPECIFICATION

9. The disclosure is objected to because of the following informalities: (1) some of the subscripts, atoms, and bonds are difficult to read, please see page 10, lines 11-12

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and page 16, line 15. (2) page 14, line 6, replace 'Best Modes of Carrying Out The Invention' with 'Brief Description of the Drawing' since a description of Figure 1 is provided following the heading.

Appropriate correction is required.

#### **COMMENTS/NOTES**

10. It is duly noted that no prior art has been cited against the instant invention. However, Applicant MUST address and overcome the double patenting and 112 rejections above.


11. Applicant is respectfully requested to correct the spelling of 'independently' in claim 18, line 9.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones  
Primary Examiner  
Art Unit 1616

October 18, 22004